

DETAILED ACTION

Applicant's amendments and arguments received 11/13/2007 have entered and considered. Claims 2, 6 and 10 have been canceled. An examination of pending claims 1, 3-5, and 7-9 is herein presented.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Regarding claim 5, claim 1 recites that the entire top is at a continuous angle. However, claim 5 recites that the housing is rounded at the top. If a housing top is rounded, the angle inherently must vary at that section in order to create a round shape. For purposes of examination it is assumed that the angle of the top is sloped at a continuous angle between the rounded apex at the top and the bottom side of the top.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

2. Claims 1 and 7 are rejected under 35 U.S.C. 102(a) as being anticipated by Raptor Guard 2004. Regarding claims 1 and 7, Raptor Guard 2004 discloses a cross-

Art Unit: 3633

armed utility pole guarding device for preventing raptor nesting, wherein the utility pole can have a plurality of cross arms (see right top box), the guarding device comprising a housing (Figs. 2) having a continuous smooth surface of non-concoctive, non-sticky material having a sloped top (upper 3-1/2") at a continuous angle through the entire top of at least 45 degrees to prevent debris from accumulating at the top of said housing, and the sides (angled sides of 2-1/2") of the housing extending down from said top of said housing, said sides having spaced holes (upper left Fig.) suitable for screwing said side of said housing into said cross-arms of said utility pole.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 3-5 and 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ogawa et al. (JP 09028267A) in view of Raptor Guard 2004.

a. Regarding claims 1 and 7, Ogawa et al. discloses a cross-arm utility pole guarding device (Fig. 1,3), said utility pole having a plurality of cross-arms (b), the guarding device comprising a housing (c) made of non-conductive, non-sticky material having a sloped top (Fig. 2) to prevent debris from accumulating at the top of said housing, the sides (7) of the housing extending down from said top of the housing, said sides having spaced holes (Fig. 1) suitable for screwing said side of said housing into said cross-arms of said utility pole (Fig. 3,4). Ogawa et

al. does not disclose that the housing has a continuous smooth surface sloped at a continuous angle of at least 45 degrees. However, it is notoriously well known in the art that housings for guarding devices can comprise a continuous smooth surface sloped at a continuous angle of at least 45 degrees. For example, Raptor Guard teaches guarding device for preventing raptor nesting, wherein the utility pole can have a plurality of cross arms (see right top box), the guarding device comprising a housing (Figs. 2) having a continuous smooth surface of non-concoctive, non-sticky material having a sloped top (upper 3-1/2") at a continuous angle through the entire top of at least 45 degrees to prevent debris from accumulating at the top of said housing, and the sides (angled sides of 2-1/2") of the housing extending down from said top of said housing, said sides having spaced holes (upper left Fig.) suitable for screwing said side of said housing into said cross-arms of said utility pole. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Ogawa et al. to use a continuous smooth surface at a continuous angle of at least 45 degrees, such as taught by Raptor Guard 2004, in order to simplify the manufacturing process and better protect against nesting pests. Furthermore, it would have been a matter of obvious design choice to form the housing as having a continuous smooth surface with a sloped top at a continuous angle of at least 45 degrees, as such a modification would have involved a mere change in shape of a component. A change in shape is generally recognized as being

within the level of ordinary skill in the art. In re Dailey, 149 USPQ 47 (CCPA 1966).

b. Regarding claims 3 and 8, more than one housing is attached to the cross-arms wherein the space separating the housing is less than 4 inches (Fig. 3).

c. Regarding claims 4 and 9, Ogawa et al. discloses the invention as claimed except for the housing comprising a clear plastic with a UV protective layer. However, it would have been a matter of obvious design choice to form housing out of a clear plastic with a UV protective layer, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

d. Regarding claim 5, Ogawa et al. discloses the invention as claimed except for the housing being rounded at the top of the housing. However, it would have been a matter of obvious design choice to form the housing as having a rounded top, as such a modification would have involved a mere change in shape of a component. A change in shape is generally recognized as being within the level of ordinary skill in the art. In re Dailey, 149 USPQ 47 (CCPA 1966). Furthermore, no criticality is given for why the shape of the housing is round.

Response to Arguments

5. Applicant's arguments filed 11/13/2007 have been fully considered but they are not persuasive. In response to applicant's argument that the references fail to show

certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., screwed into the side arms of the cross-arms) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Note that even if the Raptor Guard 2004 sits on top of the cross-arms the supplied holes in the sides of the Raptor Guard make the Raptor Guard capable of being secured to cross-arms of a utility pole via screws, as the holes are located at the bottom edge of the Raptor Guard. Regarding applicant's argument that the sides of the Raptor Guard are not sides but the top of the housing, the Raptor Guard has 5 distinct planar faces: two top faces (length of 3-1/2"), two side faces (length of 2-1/2") and one bottom face (length of 3"). The two side faces can be considered sides of the housing as they are located on two different sides of the upper section and extend downwardly therefrom. In regards to applicant's arguments concerning Ogawa et al., applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

Art Unit: 3633

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ELIZABETH A. PLUMMER whose telephone number is (571)272-2246. The examiner can normally be reached on Monday through Friday, 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on (571) 272-6777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3633

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/Jeanette E Chapman/
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